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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,215	06/21/2001	Chad A. Stevens	10010428-1	8409

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
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EXAMINER

HUFFMAN, JULIAN D

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888,215

Applicant(s)

STEVENS, CHAD A.

Examiner

Julian D. Huffman

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,9,10,12-19 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,10,12-19 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 May 2003 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16-19 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not support the elements packaged together in a kit.

Applicant states in the response that:

"Applicant proposes amendments to claims 16 and 25 to clarify the meaning of the word 'kit' as used in the specification and claims. Applicant proposes to explicitly adopt that definition of the term "kit" in claims 16 and 25 which includes a set of items "packaged" together. Such claim language is within the established definitions of the term "kit" as recognized by the outstanding office action".

Respectfully, the office action does not recognize the aforementioned definition for the word kit. The office action states that:

"Applicant provides definitions [in the response] for the word 'kit'. The most specific of which describes a kit as a 'packaged set of related materials', while the most broad definition describes a kit as a 'set of articles or implements used for a specific purpose'. Applicant's disclosure does not mention packaging of the sticker print medium... Since the specification makes no mention of packaging materials into a set for sale, the term kit is considered to refer to a set of articles or implements used for a specific purpose, as this is the broadest definition which is consistent with the disclosure".

With regards to applicant's dictionary definitions, the term kit is also defined in the dictionary as "a young or undersized fur-bearing animal" and also as "a small narrow violin", the point being that there are many definitions for the term kit, which vary depending on which dictionary is used, or how the word is intended to be used. What is important is the definition which is most reasonable with applicant's disclosure, and in this instance, it is the broadest definition which defines a kit as a set/collection of articles or implements.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. With regards to claims 12-14, Floegel et al. disclose an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (element 12);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 11-15);

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (element 14);

wherein said sticker print medium is made of vinyl (column 4, lines 61-62); and

wherein said sticker print medium is transparent (column 1, lines 29-35).

6. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Longtin (U.S. 5,334,431).

Longtin discloses an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (the sticker was inherently blank before it was printed upon);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 6-9); and

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (fig. 1, element 20, column 1, lines 22-31);

wherein said sticker print medium is made of transparent vinyl (column 3, lines 8-10 and 15-16);

wherein the sheet is perforated to define a plurality of sticker panes (fig. 1).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain.

Floegel et al. disclose a method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium (column 1, lines 13-16), said sticker print medium being of a non-conductive material on which an electrostatic

charge can be maintained such that said sticker print medium functions as an electrostatic sticker (column 1, lines 56-58 and column 2, lines 30-32);

depositing an electrostatic charge on said sticker print medium with a charge donor (column 3, lines 11-14);

applying said sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied (column 4, lines 39-40, both sides are charged, lines 22-26); and

perforating one or more sections of said sticker print medium (column 3, lines 25-28).

Floegel et al. do not disclose depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

However, Chamberlain discloses depositing a charge to a print medium during mounting of the medium to a surface, wherein said charge donor is separate from, and not a part of, said sticker print medium (column 1, line 55-column 2, line 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an electrical charge on the medium in the manner taught by Chamberlain. The reason for performing the modification would have been to increase the strength of attraction or adhesion when mounting the medium (column 2, lines 1-2).

**9.** Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain as applied to claim 1 above and further in view of Suzuki et al. (U.S. 4,882,621).

Floegel et al. as modified by Chamberlain disclose everything claimed with the exception of reversing the image when printing it.

Suzuki et al. discloses a printing device which uses a mode setting switch (16) to enable a mirror image converting circuit (4) to perform a mirror image conversion on data from a host apparatus when transparencies are used as the recording medium, such that the image may be viewed normally after printing (column 2, lines 43-47 and column 3, lines 36-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Suzuki et al. into the invention of Floegel et al. as modified by Chamberlain. The reason for performing the modification would have been to enable image data to appear in the proper orientation when printing on a transparent media.

**10.** Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain and Suzuki et al. as applied to claim 2 above, and further in view of Naik et al. (U.S. 5,579,446).

Floegel et al. as modified do not disclose the host computer with a printer driver performing the reversing operation of the image.



However, Naik et al. discloses a host computer which performs image processing, then sends the processed image to the printer through a printer driver (fig. 1, column 5, lines 34-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Floegel et al. as modified to perform the processing using a printer driver of the host computer. The reason for performing the modification would have been to reduce the cost and complexity of the printing apparatus by performing computations using the host computer.

**11.** Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain in view of Greenberg (U.S. 3,589,507).

Chamberlain discloses an electrostatic sticker kit comprising:  
a kit including:

at least one blank sheet of an electrostatic sticker print medium (column 1, lines 50-54, the sticker was blank before it was printed on); and

a charge donor other than said sticker print medium for depositing an electrostatic charge on either side of said sticker print medium after said sticker print medium has been printed with an image (column 1, line 55-column 2, line 7);

wherein said at least one blank sheet of sticker print medium and said charge donor are associated together in said kit (the sticker and the charge donor could be considered part of a kit which allows a sticker to be reliably attached to a structure);

wherein said sticker print medium is made of vinyl (column 1, lines 21-22, Koroseal is one of the most popular forms of vinyl);

wherein said sheet of print medium is perforated to define a plurality of sticker panes (column 2, lines 45-52); and

wherein said sticker print medium is transparent (column 3, lines 19-24).

Chamberlain does not expressly disclose the sticker packaged in a kit.

Greenberg disclose packaging a display device in a kit (fig. 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to package the invention of Chamberlain, as suggested by Greenberg. The reason for performing the modification would have been to facilitate sale to an end user.

**12.** Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubino in view of Greenberg.

Rubino discloses a method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one blank sheet of an electrostatic sticker medium and a charge donor, other than said sticker medium, for depositing an electrostatic charge on either side of said sticker medium (abstract), wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are associated together to form said kit. Further the sticker medium is capable of use in a printing device and was used in such a device to produce a decorative image thereon.

Rubino does not expressly disclose the sticker packaged in a kit.

Greenberg disclose packaging a display device in a kit (fig. 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to package the invention of Rubino, as suggested by Greenberg. The reason for performing the modification would have been to facilitate sale to an end user.

### ***Response to Arguments***

13. Applicant's arguments are not persuasive for the reasons indicated in the advisory action, paper number 8, mailed on 4 June 2003.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (703) 308-6556. The examiner can generally be reached Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier, can be reached at (703) 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722. Faxes requiring the immediate attention of the examiner may be sent directly to the

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examiner at (703) 746-4386. Note that this number will not automatically send a confirmation that the fax was received.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JH

15 September 2003



Stephen D. Meier  
Primary Examiner